

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

LEVERGOOD *et al.*

Appl. No.: 09/548,235

Filed: April 12, 2000

For: **Web Advertising Method**

Confirmation No.: 6069

Art Unit: 2452

Examiner: WINDER, Patrice L.

Atty. Docket: 3057.0020002

Twenty-First Supplemental Information Disclosure Statement

Mail Stop Amendment

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Commissioner:

Notice of Prior and Concurrent Proceedings

Applicants hereby call to the attention of the Patent and Trademark Office the following reexamination proceedings involving a patent that is directly related to the above-identified patent application:

Proceeding	Status
<i>Ex Parte</i> Reexamination of U.S. Patent No. 5,708,780 (Control No. 90/007,183)	Reexamination Certificate Issued: March 15, 2006
<i>Ex Parte</i> Reexamination of U.S. Patent No. 7,272,639 (Control No. 90/011,444)	Reexamination Certificate Issued: September 29, 2011
<i>Ex Parte</i> Reexamination of U.S. Patent No. 7,272,639 (Control No. 90/011,937)	Reexamination Certificate Issued: February 1, 2013

A document which may be material to the related *Ex Parte* Reexaminations that is not already of record in this patent application is listed on the accompanying Form PTO/SB/08a as document **US1**. If the Examiner should wish to review any other materials, information or documents from the related Reexaminations, copies can be provided to the Examiner upon request.

Notice of Related Litigation

Applicants hereby call to the attention of the Patent and Trademark Office the following litigations involving a patent that is directly related to the above-identified patent application:

Case	Status
<i>Soverain Software LLC v. Amazon.com, Inc., et al.</i> (E.D. Tex. 6:04-cv-00014)	Dismissed
<i>Soverain Software LLC v. CDW Corporation et al.</i> , (E.D. Tex. 6:07-cv-00511)	Federal Circuit Decision Reversed In Part and Vacated In Part
<i>Soverain Software LLC v. J.C. Penney Corporation, Inc. et al.</i> , (E.D. Tex. 6:09-cv-00274)	Notice of Appeal filed

A document which may be material to the related litigations that is not already of record in this patent application is listed on the accompanying Form PTO/SB/08b and submitted herewith as document **NPL1**. If the Examiner should wish to review any other materials, information or documents from the related Reexaminations, copies can be provided to the Examiner upon request.

Information Disclosure Statement

Listed on accompanying IDS Forms PTO/SB/08a equivalent and PTO/SB/08b equivalent are documents that may be considered material to the patentability of this application as defined in 37 C.F.R. §1.56, and in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.97 and 1.98.

Applicants have listed publication dates on the attached IDS Forms based on information presently available to the undersigned. However, the listed publication dates

should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, OR before the mailing date of a first Office Action on the merits OR

before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.

- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.

- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☐ c. The required fee is provided through online credit card payment authorization in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but on or before payment of the Issue Fee. The required fee is provided through online credit card payment authorization in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38 and MPEP 609.04(a)(III).
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below in accordance with 37 C.F.R. § 1.98(a)(3).
- ☒ 7. A copy of document **NPL1** is submitted. However, in accordance with 37 C.F.R. § 1.98(a)(2), ***no copy of U.S. patent cited as document US1 on the attached IDS Form is submitted.***
- ☐ 8. Copies of the _____ documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. _____, filed _____, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
- ☒ 9. It is expected that the examiner will review the prosecution and cited art in the parent application nos. **09/005,479**, filed January 12, 1998 (now U.S. Patent No. 7,272,639, issued September 18, 2007) and **08/474,096**, filed June 7, 1995 (now U.S. Patent No. 5,708,780, issued June 13, 1998) in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

☐ 10. In accordance with the Federal Circuit decision in *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358 (Fed. Cir. 2003), Applicants submit herewith Office Actions from the co-pending U.S. Patent Application No. _____, filed _____, as documents _____ to _____.


The identification of these Office Actions is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Salvador M. Bezos
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Date: 11 Feb 2012

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(Use as many sheets as necessary)

Sheet

1

of

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Application Number

09/548,235

Filing Date

April 12, 2000

First Named Inventor

Thomas M. LEVERGOOD

Art Unit

2452

Examiner Name

Winder, Patrice L.

Attorney Docket Number

3057.0020002

Examiner
initials*

Cite
No. ¹

Document Number

Number-Kind Code ² (if known)Publication Date
MM-DD-YYYY

10-03-1995

Name of Patentee or
Applicant of Cited Document

Russell

Pages, Columns, Lines, Where
Relevant Passages or Relevant Figures Appear

US1

5,455,953

10-03-1995

Levergood

US2

7,272,639 C2

02-01-2013

Levergood *et al.*

Examiner
initials*

Cite No.¹

Foreign Patent Document.

Country Code³-Number⁴-Kind
Code⁵ (if known):

Publication

Date
MM-DD-YYYY

Name of Patentee or
Applicant of Cited Document

Pages, Columns, Lines, Where
Relevant Passages or Relevant
Figures Appear

T6

Examiner
Signature

Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

[illegible]

Examiner Signature		Date Considered	
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¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.